REMARKS

This Amendment is submitted in response to the Office Action dated October 28, 2004, having a shortened statutory period set to expire January 28, 2005, extended to February 28, 2005 through the one-month extension of time requested below. Claim 1 has been amended and claims 2-32 have been cancelled, and claims 33-52 have been newly added. Thus, claims 1 and 33-52 are currently pending.

Examiner Interview on February 18, 2005

Applicants appreciate the courtesy extended by the Examiner in a telephone interview on February 18, 2005. During that interview, the Examiner has provided valuable advice concerning the features of amended Claim 1. Applicants have revised the amended claims to reflect the advice provided by the Examiner.

Claim Rejections Under 35 U.S.C. § 101

At paragraph 3 of the present Office Action, the Examiner has rejected claims 1-13 for failing to recite statutory subject matter. Applicants have corrected this deficiency by amendment of claim 1 and cancellation of Claims 2-32. Applicants thank the Examiner for his attention to detail.

Claim Objections Under 35 U.S.C. § 112

At paragraph 5 of the present Office Action, the Examiner has rejected claims 20-32 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Applicants have corrected this deficiency by canceling claims 2-32 and by specifically reciting a computer-readable medium in claim 46. Applicants thank the Examiner for his attention to detail.

Claim Rejections Under 35 U.S.C. § 102

At paragraph 6 of the present Office Action, the Examiner has rejected Claims 1-3, 5-9, 11, 13-17, 20-22, 24-28, 30 and 32 as being anticipated by U.S. Patent No. 5,659,742 to Beattie

et al. (*Beattie*). Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp v. Applied Digital Data Systems*, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (Fed. Cir. 1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). Applicants respectfully submit that *Beattie* does not disclose all elements of Applicants' invention as recited in amended exemplary claim 1, and Applicants respectfully traverse the Examiner's rejections, insofar as they might be applied to amended claim 1 and new claims 33-52. Applicants respectfully submit that amended claim 1 and new claims 33-52 are not anticipated by *Beattie*.

When taken as a whole, *Beattie* is directed to "provide many publishers that provide documents to information retrieval systems [and] require record-keeping in order to insure accurate royalty payments" (*Beattie*, Col. 2, lines 46-49) with "a searching/retrieval system which can query a library or database" (*Beattie*, Col. 2, lines 58-59) and "a searching/retrieval system that tracks not only how often each document stored in the system database was retrieved by users, but also the demographics of the users retrieving the documents" (*Beattie*, Col. 2, lines 47-49).

Applicant respectfully submits that *Beattie* does not render the present invention unpatentable because *Beattie* does not explicitly or inherently disclose "removing said digital content from said digital document accessible to said computer program product on said first data processing system," as recited in exemplary claim 1. The Examiner cites *Beattie* at Figure 1 as disclosing the step of 'detaching content from a document'. The cited figure from *Beattie* fails to disclose "removing said digital content from said digital document" or detaching or removing anything else. Instead, the text associated with Figure 1 discloses a system for querying an existing database, when it recites:

> Referring now to **FIG. 1**, there is shown a simplified block diagram illustrating an information retrieval system **100**, in accordance with a preferred embodiment of the present invention. The information retrieval system **100** includes a user station **102** for searching information files which have been collected from various publisher sources **112** and stored in data center **110**. The user station **102** includes

a personal computer (PC) **104** and user software **106** which resides on PC **104**. User software **106** includes a graphical user interface (shown generally in **FIGS. 4A, 4B** and **4C**). The user station **102** provides search queries by way of a communications channel **108** (such as, for example, a large volume public network or the Internet) coupled to the data center **110**. The data center **110** includes session server **114** which includes means for receiving a search query from user station **102**, means for sending the search query to a query server **116**, means for receiving search results information from the query server **116**, means for sending a search results list representative of the search results information across communications channel **108** to the user station **102**, means for receiving a document retrieval request transmitted from user station **102** over communications channel **108** to session server **114**, and means for retrieving a document from database **118** in response to the retrieval request and transmitting a file representative of the document to user station **102** over communications channel **108**. The query server **116** at data center **110** includes means for receiving a search query from the session server **114**, searching means for searching a document index database **117** (shown in **FIG. 3**) to identify documents responsive to the search query, and means for sending search results information representative of the documents identified by the searching means from the query server **116** to the session server **114**. Data center **110** also includes a library database **118** for storing text, image, audio or other multi-media information representative of files provided by a plurality of publishers **112**. As explained more fully below, session server **114** retrieves (from library **118**) documents identified by a search query and selected by a user of user station **102** for retrieval, and then transmits the selected documents to the user station **102** over channel **108**. (*Beattie* at Col. 8, line 50- Col. 9, line 21).

Applicants respectfully submit that because *Beattie* does not disclose "removing said digital content from said digital document accessible to said computer program product on said first data processing system", *Beattie* does not anticipate Applicants' amended Claim 1.

Further, Applicants' amended Claim 1 recites "replacing said extracted digital content from said digital document accessible to a computer program product on a first data processing system with a URL link placeholder". With reference to this step, the Examiner cites Figures 4A and 5, Column 8, lines 60-64, and Column 11, lines 60-65 of *Beattie*. The cited figures of *Beattie* fail to disclose replacing anything, and further fail to disclose the use of a URL link placeholder. In addition, the first cited text recites:

The user station **102** provides search queries by way of a communications channel **108** (such as, for example, a large volume public network or the Internet) coupled to the data center **110**. The data center **110** includes session server **114** which includes means for receiving a search query from user station **102**, means for sending the search query to a query server **116**. (*Beattie* at Col. 8, line 60-64).

Similarly, the second cited text recites:

In addition, in step **315** the enrollment means **120** requests the user to provide personal "enrollment information" about him/herself such as, for example, the user's full name, address, grade level, gender, occupation, the occupations of the user's parents, the numbers of brothers and/or sisters of the user, the type of computer used by the user, the user's modem speed the display capabilities of the user's display, the size of the memory of the user's PC, and the identity of the communications link (e.g., the Internet, the Prodigy.RTM. network, the CompuServe.RTM. network or the Microsoft.RTM. network) used for accessing the system. (*Beattie* at Col. 11, line 60-65).

Applicants respectfully submit that neither of the cited texts recites "replacing said extracted digital content from said digital document accessible to a computer program product on a first data processing system with a URL link placeholder". Further, Figure 4A and Figure 5 do not disclose 'replacing' or any reference to a URL link placeholder. Because *Beattie* does not disclose "replacing said extracted digital content from said digital document accessible to a computer program product on a first data processing system with a URL link placeholder", Applicants respectfully submit that *Beattie* does not anticipate Applicants' amended Claim 1.

Claim Rejections Under 35 U.S.C. § 103

At paragraph 9 of the present Office Action, the Examiner has rejected Claims 4, 10, 12, 18, 19, 23, 29 and 31 as unpatentable under 35 U.S.C. 103(a) over *Beattie*. That rejection is rendered moot by the cancellation of Claims 2-32.
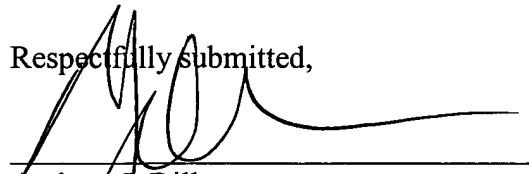
Conclusion

Applicants invite the Examiner to contact the undersigned attorney of record at (512) 343-6116 if such would further or expedite the prosecution of the present Application.

A one month extension of time for this response is believed to be necessary. A request for one month extension of time and a check in the amount of $120.00 are enclosed herewith.

No other fees are believed to be necessary; however, in the event an additional extension of time is required, that extension of time is hereby requested. Please charge any fees associated with any extension of time as well as any other fee necessary to further the prosecution of this application to **IBM CORPORATION DEPOSIT ACCOUNT No. 09-0447**.

Respectfully submitted,

Andrew J. Dillon
Reg. No. 29,634
DILLON & YUDELL LLP
8911 North Capital of Texas Highway
Suite 2110
Austin, Texas 78759
Telephone (512) 343-6116
Facsimile (512) 343-6446
ATTORNEY FOR APPLICANTS